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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,379	01/30/2002	Thomas C. McFarland	100200351-1	4528

7590 10/09/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,379

Applicant(s)

MCFARLAND ET AL.

Examiner

Hai C Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-25, 27-29 and 31-41 is/are rejected.
- 7) ☒ Claim(s) 13, 26 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The following claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1:
- Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for being incomplete. A system is claimed for *labeling a storage media* in which a means for printing images is provided. However, it is not clear whether the printing means is used to print the images encoded on the storage media onto either any recording medium or a label to be affixed to the storage media or the non-data surface of the storage media.
- Claim 37:
- Similarly, Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for being incomplete since it is not known whether the preparation of a composite file is for printing the claimed label.

Claims 2-5 and 38-41 are dependent from claims 1 and 37 above, and are therefore indefinite.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4-11, 18-19, 22, 24, 27-29, 31-34, 37-39 are rejected under 35 U.S.C. 102(be) as being anticipated by Van Valer (Pub. No. U.S. 2002/0145614 A1).

Van Valer discloses a method for labeling of photo compact discs with a photo table of contents, the method consisting of selecting the digital photos to be stored on a target photo compact disc and designing the photo table contents label that will be printed onto that target photo compact disc, the selection and collection of the digital photos being downloaded by the user from a Web server and temporarily stored into the user-end system (paragraph [0012]), which coordinates with the index sizing module to ensure that the user is not attempting to overload the capacity of the printable surface

area on the target CD, e.g. the maximum number of standard thumbnail images that can be imprinted onto the non-data surface area of the target CD as a label (paragraph [0013]). With regard to claims 6, 18, Van Valer further teaches the printing of said arranged images being directed to an adhesive label that can be affixed onto the surface of the target CD.

Van Valer further teaches:

- means for storing a composite file that included the arranged images (the XML-to-label-image converter transforming the XML data and the associated thumbnail images into a simple bitmap image of the TOC sized to the proportions of the target photo compact disc (paragraph [0013]);
- means for printing said images including a laser (using an HP LaserJet printer);
- said means for printing said images including a printhead that prints said images on a side of said storage media (labeling of photo compact discs with a photo table of contents including printing directly onto the plastic CD or onto an adhesive label (paragraph [0062]);
- printing a title (album title) onto said label prior to the step of affixing, a title encoded on said storage media or received from a user (paragraph [0062]);
- the label including an adhesive (adhesive label);
- the second side including at least one image that does not correspond to an image encoded on said storage media (the user can include a user-specified arbitrary images to be printed on the label) (paragraph [0081]);
- printing using a laser (using an HP LaserJet printer);

- said second side responding thermochromically to said laser (using a standalone thermal CD printer);
- with regard to claim 33, Van Valer indicates the use of a browser-based system that automatically downloads the selected images to be printed onto a label).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 12, 35, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer in view of Kahle (U.S. 6,074,031).

Van Valer discloses all the basic limitations of the claimed invention except for the user-input of the size of the storage media.

Kahle, an acknowledged prior art, discloses a method and apparatus for printing labels on digital recording media in which the label data is encoded on the digital recording media (col. 5, line 66 to col. 6, line 5), and means for printing (label printer 12) being connected to a driver, which provides a template showing the outline of the label as well as the label formatting and data sorting (col. 5, lines 26-40). Kahle further teaches the input device accepting an input indicating a size of the storage media (the template for outlining the label indicating the size of the storage media) (col. 5, lines 45-55).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Van Valer with the aforementioned teaching of Kahle. The motivation for doing so would have been to allow the label to be cut proportional to the size of the storage media.

7. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer in view of Tracy (U.S. 5,770,289).

Van Valer discloses all the basic limitations of the claimed invention except for the label having grooves that permit portion of the label to be separate from the backing material, the groove having the shape of the disk.

Tracy teaches die cut self-adhesive label sheet for labeling CD-ROMs, the label sheet being provided with a groove that traces the shape of the CD-ROM such that the printing of the entire label is allowed while the label sheet is fed through the printer paper feed mechanism.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the label on a label sheet with groove delimiting the label portion as taught by Tracy in the device of Van Valer. The motivation for doing so would have been to provide printing of a plurality of labels in a single paper-fed process using the printer paper feed mechanism as indicated by Tracy at col. 2, lines 38-42.

8. Claims 14-17, 23, 25, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer in view of Levy (Pub. No. U.S. 2002/0146147 A1).

Van Valer discloses all the basic limitations of the claimed invention except for the background and artwork printing.

Levy discloses encoded data of watermark to be printed on a label for an optical disk along with the printing the label's background on the label.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Van Valer, with the aforementioned teaching of Levy for the purpose of the image of watermark on the label to be easily discerned.

Allowable Subject Matter

9. Claims 13, 26, 30, 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: the primary reason for the indication of the allowability of the claimed invention is the inclusion of the limitation "receiving an indication from a user that indicates the size of a label page that includes said label", in the combination as currently claimed in

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claims 13 and 41, the inclusion of the limitation "said images are printed within an area that is substantially larger than the area required to cover at least one side of said storage media", in the combination as currently claimed in claims 26, and the inclusion of the limitation "said second side of said storage media includes microencapsulated fluid droplets that respond to said laser", in the combination as currently claimed in claims 30, and which are not found taught or fairly suggested by the prior arts made of record, considered alone or in combination.

Response to Arguments

12. Applicant's arguments with respect to claims 1-12, 14-25, 27-29, 31-40 have been considered but are moot in view of the new grounds of rejection as presented in this Office action:

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM
PRIMARY EXAMINER

September 30, 2003